

### **REMARKS**

This is a reply to the Office Action dated September 29, 2009, in the above-referenced patent application. Applicant thanks the Examiner for carefully considering the application.

#### **Status of Claims**

Claims 1-7 are currently pending. Claim 1 is independent.

Claim 4 is objected to for informalities. Claims 1-7 are rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,407,625 issued for Shum ("Shum"), in view of U.S. Patent Pub. No. 2002/0014017 for Egan ("Egan")

#### **Claim Amendments**

Claims 1-7 are amended for clarification. No new matter is added.

#### **Claim Objections**

Claim 4 is objected to for including a typographical error. Applicant has amended claim 4 to overcome the informal objection.

Accordingly, withdrawal of the informal objection of claim 4 is respectfully requested.

#### **Rejections under 35 U.S.C. §103(a)**

The rejection of claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over Shum in view of Egan is respectfully traversed for at least the following reasons: Shum and Egan either separately or combined, does not disclose all of the claimed limitations.

According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” And, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007).

Additionally, according to MPEP §2143

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed

invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

Applicant's claim 1 requires, in part, "holding rods attached thereto in an articulated manner *configured for holding and positioning a targeting device for a medical instrument, wherein the target device is mounted on two adjustment arms which are each independently movable by means of an actuating drive on the free ends of the holding rods* in the X- and/or Y-plane (emphasis added).

Shum discloses a multi-arm robot device. The robot device in Shum shows a gripper 78 made up of two portions, a stationary holding portion and a moveable holding portion. The gripper 78 in Shum only moves the moveable portion of the gripper towards the stationary portion in order for gripping an item (see Shum, Fig. 9). Therefore, the gripper of Shum does not teach "*the target device is mounted on two adjustment arms which are each independently movable*" (emphasis added) as required, in part, by amended claim 1. Further, gripper of Shum does not teach or suggest "*the target device is mounted on two adjustment arms which are each independently movable by means of an actuating drive on the free ends of the holding rods*" (emphasis added) as required, in part, by amended claim 1. That is, the gripper 78 of Shum does not have two actuating drives that each control independent movement of an associated adjustment arm.

Additionally, Applicant notes that while the "arms" disclosed in Shum may be independently moveable, the arms in Shum are not equivalent to the arms claimed by Applicant.

That is, the arms 12, 14 and 16 of Shum would relate to the holding rods 3 and 4 of Applicant's claimed invention (see Shum, Figs. 1-2, col. 2, lines 10-25; Applicant's Figs. 1-2).

Egan teaches an anthropometric frame system including a base, a foot frame device for selectively measuring or placing feet of a subject in a preferred or selected stance orientation on the base and an orthogonal frame device for measuring the spacial relationships of various bony points on the subject's body.

It is clear that the combination of Shum and Egan does not teach or disclose "holding rods attached thereto in an articulated manner *configured for holding and positioning a targeting device for a medical instrument*, wherein *the target device is mounted on two adjustment arms which are each independently movable by means of an actuating drive on the free ends of the holding rods*" (emphasis added) as required, in part, by amended claim 1. This is readily seen by the device of Shum having a completely different purpose related to holding large items. That is, the arms 12, 14 and 16 of Shum, or even the gripper 78, does not teach or suggest "holding rods attached thereto in an articulated manner *configured for holding and positioning a targeting device for a medical instrument*" (emphasis added). Indeed, if Shum were to attempt to hold a targeting device for a medical instrument, the medical instrument would more than likely be damaged due to the coarseness of gripping adjustment by a gripper 78. Additionally, the size of the device in Shum would be prohibitive to be used in a similar fashion as Applicant's claimed invention. That is, if the device in Shum were combined with the base plate of Egan, how would the device be placed on an operating table without causing damage?

Based on the above, the combination of Shum and Egan cannot teach or suggest “holding rods attached thereto in an articulated manner *configured for holding and positioning a targeting device for a medical instrument*, wherein *the target device is mounted on two adjustment arms which are each independently movable by means of an actuating drive on the free ends of the holding rods* in the X- and/or Y- plane (emphasis added) as required, in part, by amended claim 1.

Dependent claim 3 requires, in part, “a guide tube for the medical instrument is mounted on the free ends of the adjustment arms, especially by way of ball heads” (emphasis added). It is asserted in the Office Action that Shum discloses a guide tube (references 20, 78). These elements of Shum, however, refer to grippers. Applicant’s guide tube 9 is completely distinguishable from the grippers of Shum. Moreover, a tube is defined as a cylindrical structure. It is clear that the grippers in Shum are not cylindrical or even tube-like.

Dependent claim 4 requires, in part, “the base plate comprises a scaffold- or portal-like frame, and *the scaffold- or portal-like frame is configured for surrounding a patient*” (emphasis added). The equivalent element in Egan would be the rigid horizontal bar 110 that is mounted for selected vertical movement relative to vertical poles 100, 102 (*see e.g.*, Egan, Fig. 1). These elements described in Egan, however, are not configured for surrounding a patient.

Dependent claim 6 requires, in part, “the two actuating drives are arranged directly above one another and are preferably arranged as flat boxes, and *each actuating drive controls movement of an associated adjustment arm*” (emphasis added). Dependent claim 7 requires, in part, “the actuating drives each comprise a compound slide for *independently adjusting the*

*respective adjustment arm in the X-Y plane*” (emphasis added). As asserted above, the adjustment arms in Applicant’s claimed invention would not be equivalent to the arms 12, 14 and 16 of Shum, but more like the portions of the grippers 20/78. Shum does not teach or suggest the gripper “arms” are controlled by separate actuating drives associated with each “arm” portion, or that the gripper “arms” can be independently adjusted in the X-Y plane.

Further, the assertions made in the Office Action on pages 2-3 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP §2142 cannot be found. Additionally, since the combination of Shum and Egan does not teach, disclose or suggest all the limitations of Applicant’s amended claims 1-7, as listed above, Applicant’s claims 1-7 are not obvious over Shum in view of Egan since a *prima facie* case of obviousness has not been met under MPEP §2143. Thus, claims 1-7 of the present application are patentable over Shum in view of Egan for at least the reasons set forth above.

Accordingly, withdrawal of the rejection of claims 1-7 is respectfully requested.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant believes that all currently pending claims are in condition for allowance. Reconsideration, re-examination, and allowance of all claims are respectfully requested. If the Examiner believes that a telephone interview will help further the prosecution of this case, Applicants respectfully request that the undersigned attorney be contacted at the listed telephone number.

Please direct all correspondence to **Myers Andras Sherman LLP**, 19900 MacArthur Blvd., 11<sup>th</sup> Floor, Irvine, California 92612.

Respectfully submitted,

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